REMARKS

Please note the fact that August 12, 2006, fell on a Saturday ensures that this paper is timely filed as of today, Monday, August 14, 2006 (the next succeeding day which is not a Saturday or Sunday).

In the Office Action dated May 12, 2006, pending Claims 15-42 were rejected and the rejection made final. In response Applicants have filed herewith an Amendment After Final and have amended independent Claims 15, 23, 28, and 30 to correct informalities in the claims. Claims 16-21, 31-36, and 38-42 are dependent, and claims 22, 24-27, 29, and 37 are withdrawn from consideration. Applicants intend no change in the scope of the claims by the changes made by this amendment. It should be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Examiner is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the foregoing amendments and the following remarks.

Objection to claims 15, 23, 28, and 30:

The Examiner objected to claims 15, 23, 28, and 30 for informalities present in those claims. In response, Applicants have amended claims 15, 23, 28, and 30 to incorporate the changes suggested by the Examiner in order to expedite prosecution. Applicants note that the present amendments to claims 15, 23, 28, and 30 are made to

address the Examiner's objections and not to overcome any cited prior art. Applicants respectfully request that the Examiner withdraw the objection to claims 15, 23, 28, and 30.

Rejection of claims 15-18, 23, 28, and 30-33 under 35 U.S.C. § 103(a) over Nakamura ('312):

Claims 15-18, 23, 28, and 30-33 stand rejected as being unpatentable over U.S. Patent 6,185,312 to Nakamura et al. (hereinafter Nakamura ('312)) under 35 U.S.C. § 103(a).

The Examiner asserts the following on pages 4-5 of the outstanding Office Action:

> **It is noted Nakamura et al differs from the present invention in that it fails to particular disclose alternative embedding options where the embedding of all the additional information is determined to change the length of the video data stream. However, Examiner takes Official Notice that such embedding option based on the determination whether the embedding of all the additional information will change the length of the video data stream is notoriously well known in the art.**
>
> **Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, having the reference of Nakamura et al before him/her, to exploit the other available area of video frame (e.g. vertical and horizontal sync interval), in order to embed additional data yet not change the length of the video data stream.**

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103(a). Applicants further respectfully traverse the Examiner's taking of Official Notice that the claimed subject matter of "embedding . . . based on a determination whether the embedding of all the additional information will change the

length of the video data stream and where the embedding of all the additional information is determined to change the length of the video data stream, embedding ½ of the additional data if the embedding of ½ does not change the length of the video data stream" is notoriously well known in the art.

With regards to the Examiner's taking of Official Notice, Applicants respectfully submit that the Examiner has the burden of providing "substantial evidence" to support the factual conclusion that claimed subject matter is notoriously well known in the art. MPEP § 2144.03.

The Examiner should only take Official Notice unsupported by documentary evidence when the facts asserted to be well known "are capable of instant and unquestionable demonstration as being well known" so as to defy dispute. MPEP § 2144.03(A). It is **not appropriate** for the Examiner to take Official Notice asserting facts not capable of instant and unquestionable demonstration without citation of a prior art reference. Id. Citation to some prior art reference recognized as standard in the art is **always** necessary to support a specific assertion of specific knowledge in the prior art. Id. Assessments of common knowledge not based on any evidence in the record lack substantial evidence support. Id.

Further, the line of reasoning underlying the Examiner's decision to take Official Notice of a fact must be clear and unmistakable. MPEP § 2144.03(B). When Official Notice of common knowledge in the art is taken the Examiner must **explicitly** set forth the basis for such reasoning and "provide **specific** factual findings predicated on sound technical and scientific reasoning." Id.

The Examiner in the outstanding Office Action merely asserts an "embedding option based on a determination whether the embedding of all the additional information will change the length of the video data stream is notoriously well known in the art."

The Examiner sets forth **no** documentary evidence or prior art references to support this assertion of **specific knowledge in the art**, as is required, in order to properly take Official Notice. MPEP § 2144.03(A). Nor does the Examiner relate, **at all**, how exactly the asserted notoriously well known claimed subject matter is capable of instant and unquestionable demonstration as being well known. Id. Moreover, the Examiner **does not** provide any lines of reasoning or scientifically or technically based factual findings that support the conclusion that the claimed subject matter is notoriously well known in the art. MPEP § 2144.03(B).

For the foregoing reasons Applicants respectfully submit that the claimed subject matter subject to the Examiner's taking of Official Notice is not notoriously well known in the art and that the Examiner's taking of Official Notice is not supported by substantial evidence. MPEP § 2144.03(A), (C). The Examiner's taking of Official Notice with regards to the claimed subject matter is therefore improper.

Applicants respectfully submit that in order to maintain the current rejection the Examiner must provide concrete evidence to support the finding that the claimed subject matter is notoriously well known in the art. Or, if the Examiner's finding is based on personal knowledge, Applicants respectfully submit that the Examiner must provide an affidavit or declaration setting forth specific factual assertions and explanations that

support the Examiner's finding pursuant to 37 C.F.R. § 1.104(d)(2). MPEP § 2144.03(C).

With regards to the Examiner's rejection of the claims under § 103(a), Applicants respectfully submit that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143.

By the Examiner's own admission Nakamura ('312) does not teach the claimed subject matter of "embedding . . . based on a determination whether the embedding of all the additional information will change the length of the video data stream and where the embedding of all the additional information is determined to change the length of the video data stream, embedding ½ of the additional data if the embedding of ½ does not change the length of the video data stream." The Examiner attempts to overcome this deficiency in the teachings of Nakamura ('312) by taking Official Notice that the above-mentioned claimed subject matter is notoriously well known in the art.

Applicants respectfully submit that the Examiner's taking of Official Notice with regards to the claimed subject matter is improper as established above. The prior art then, fails to teach or suggest all of the claim limitations. The rejection is therefore improper.

For the foregoing reasons, Applicants respectfully submit that claims 15-18, 23, 28, and 30-33 are allowable over Nakamura ('312). Applicants respectfully request that the Examiner withdraw the rejection of claims 15-18, 23, 28, and 30-33 as being unpatentable over Nakamura ('312) under 35 U.S.C. § 103(a).

Rejection of claims 38-42 under 35 U.S.C. § 103(a) over Nakumura ('312) in view of Yamane ('196):

Claims 38-42 stand rejected as being unpatentable over Nakamura ('312) in view of U.S. Patent 6,393,196 to Yamane et. al. (hereinafter Yamane ('196)) under 35 U.S.C. § 103(a).

With regards to this rejection, claims 38-42 are dependent upon independent claims 15, 23, 28, and 30. Applicants respectfully submit that claims 15, 23, 28, and 30 are allowable over Nakamura ('312) as established above. Claims 38-42 are also allowable, then, for at least the same reasons as claims 15, 23, 28, and 30. Applicants respectfully request that the Examiner withdraw the rejection of claims 38-42 as being unpatentable over Nakamura ('312) in view of Yamane ('196) under 35 U.S.C. § 103(a).

Submission after Final:

Applicants respectfully submit that the foregoing amendments are made in response to Examiner's requirement of form. The amendments should therefore be entered pursuant to 37 C.F.R. § 1.116.

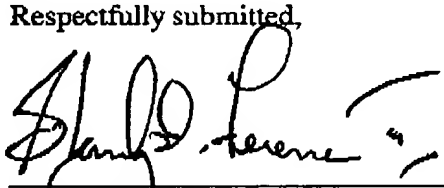
In view of the foregoing, it is respectfully submitted that independent Claims 15, 23, 28, and 30 fully distinguish over the applied art and are thus allowable. By virtue of

dependence from Claims 15 and 30, it is also submitted that Claims 16-21 and 31-42 are also allowable at this juncture.

Applicants graciously acknowledge that Claims 19-21 and 34-36 were indicated by the Examiner as being allowable if rewritten in independent form. Applicants reserve the right to file new claims of such scope at a later date that would still, at that point, presumably be allowable.

In summary, it is respectfully submitted that the instant application, including claims 15-21, 23, 28, 30-36, and 38-42, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

Customer No. 35195
FERENCE & ASSOCIATES
409 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicants